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REMARKS**CLAIM REJECTIONS -- 35 U.S.C. § 103 OVER HOSEA IN VIEW OF LADD**

Claims 1-2, 4-5, 10-11, 13-14, 19-20, and 22-23 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Hosea, *et al.* (U.S. Pub. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Hosea and Ladd must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Hosea and Ladd. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Hosea and Ladd. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, the combination of Hosea and Ladd does not establish a prima facie case of obviousness. The rejection of claims 1-2, 4-5, 10-11, 13-14, 19-20, and 22-23 should therefore be withdrawn and the case should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-2, 4-5, 10-11, 13-14, 19-20, and 22-23.

The Proposed Combination Of Hosea And Ladd Does Not Teach
Or Suggest All Of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Hosea and Ladd must disclose all of the Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 1 of the present application claims:

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1. A method for creating a session document from a presentation document, the method comprising:

identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers;

identifying a user participant for the presentation, the user having a user profile comprising user classifications; and

filtering the structured document in dependence upon the user classifications and the classification identifiers to create a session document.

Hosea Does Not Teach Or Suggest Identifying A Presentation Document For A Presentation, The Presentation Document Including A Presentation Grammar And A Structured Document Having Structural Elements Classified With Classification Identifiers

The first element of claim 1 claims "identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers...." Regarding the first element of claim 1, the Office Action at page 3 admits that Hosea does not disclose each and every element and limitation of Applicants' claims stating:

Hosea et al fails to disclose that the presentation document includes presentation grammar.

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That is, the Office Action at page 3 admits that Hosea does not disclose 'a presentation document including a presentation grammar' as claimed in the present application. Hosea, therefore, cannot possibly disclose identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers.

Further regarding the first element of claim 1, the Office Action at page 3 states that Hosea at the Abstract, lines 4-7, paragraph 0043, lines 1-5, and paragraph 0045, lines 14-16, discloses:

identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers; (Abstract, 4-7; An modified version of an HTML file is considered an presentation document. The structured document is the original HTML file. Paragraph 0043, line 1-5 discloses that a profile of the HTML file of the requested web page is formed of constituent components that include content components and formatting components wherein includes classifications of the content. Paragraph 0045, lines 14-16 discloses HTML file and its HTML profile combined being as one file, as in one document.)

That is, the Office Action takes the position that Hosea at the Abstract, lines 4-7, paragraph 0043, lines 1-5, and paragraph 0045, lines 14-16, discloses the first element of claim 1. Applicants respectfully note in response, however, that what Hosca at the Abstract, lines 4-7, in fact discloses is:

The system preferably provides to the requesting user, through a proxy server, an edited version of the HTML file for the original published Web page that is served by a host Web server.

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That is, Hosea at the Abstract, lines 4-7, discloses providing an edited version of an HTML file. Hosea's providing an edited version of an HTML file is not identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application. A presentation document is a document composed of a presentation grammar and a structured document. A presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. Hosea's providing an edited version of an HTML file, therefore, has nothing whatsoever to do with a presentation document and a presentation grammar as claimed in the present application. In fact, Hosea at lines 4-7 of the Abstract never even mentions 'presentation,' 'presentation document,' 'presentation grammar,' 'presentation document including a presentation grammar and a structured document,' or 'identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers.' Moreover, Hosea at lines 4-7 of the Abstract has nothing whatsoever to do with creating a session document from a presentation document as claimed in the present application because Hosea at lines 4-7 of the Abstract never once mentions a 'session document.' Because the combination of Hosea and Ladd does not disclose each and every element and limitation of Applicants' claims, combination of Hosea and Ladd does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to paragraph 0043, lines 1-5, Applicants respectfully note that what Hosea at paragraph 0043, lines 1-5, in fact discloses is:

A profile includes classifications for the content components of the HTML file for the requested Web page. The profile of the HTML file for the

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requested Web page is based on the same or a similar content classification scheme to the user profiles.

That is, Hosea at paragraph 0043, lines 1-5, discloses a user profile that includes classifications of the content of an HTML file requested by a user. Hosea's user profile that includes classifications of the content of an HTML file requested by a user is not identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application. As mentioned above, a presentation document is a document composed of a presentation grammar and a structured document. A presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. Hosea's user profile that includes classifications of the content of an HTML file requested by a user, therefore, has nothing whatsoever to do with a presentation document and a presentation grammar as claimed in the present application. In fact, Hosea at paragraph 0043, lines 1-5, does not even mention 'presentation,' 'presentation document,' 'presentation grammar,' 'presentation document including a presentation grammar and a structured document,' or 'identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers.' Moreover, Hosea at paragraph 0043, lines 1-5, has nothing whatsoever to do with creating a session document from a presentation document as claimed in the present application because Hosea at paragraph 0043, lines 1-5, never once mentions a 'session document.' Because the combination of Hosea and Ladd does not disclose each and every element and limitation of Applicants' claims, combination of Hosea and Ladd does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to paragraph 0045, lines 14-16, Applicants respectfully note that what Hosea at paragraph 0045, lines 14-16, in fact discloses is:

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It is contemplated that an HTML file and its profile may be merged into one combined profiled version of the HTML file rather than maintained as two separate files.

That is, Hosea at paragraph 0045, lines 14-16, discloses merging an HTML file and its profile into a combined profiled version of the HTML file. Hosea's merging an HTML file and its profile into a combined profiled version of the HTML file is not identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application. As mentioned above, a presentation document is a document composed of a presentation grammar and a structured document. A presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. Hosea's merging an HTML file and its profile into a combined profiled version of the HTML file, therefore, has nothing whatsoever to do with a presentation document and a presentation grammar as claimed in the present application. In fact, Hosea at paragraph 0045, lines 14-16, does not even mention 'presentation,' 'presentation document,' 'presentation grammar,' 'presentation document including a presentation grammar and a structured document,' or 'identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers.' Moreover, Hosea at paragraph 0045, lines 14-16, has nothing whatsoever to do with creating a session document from a presentation document as claimed in the present application because Hosea at paragraph 0045, lines 14-16, never once mentions a 'session document.' Because the combination of Hosea and Ladd does not disclose each and every element and limitation of Applicants' claims, combination of Hosea and Ladd does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

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Hosea Does Not Teach Or Suggest Filtering The Structured Document In Dependence Upon The User Classifications And The Classification Identifiers To Create A Session Document

The third element of claim 1 claims "filtering the structured document in dependence upon the user classifications and the classification identifiers to create a session document." Regarding the third element of claim 1, the Office Action at page 3 states that Hosea at paragraphs 0046 and 0047 discloses:

filtering the structured document in dependence upon the user classifications and the classification identifiers to create a session document. (Paragraph 0046-0047 discloses the use of the HTML file/profile and user profile by comparing the classifications of each content component with the user preferences to create a modified personalized web page.)

That is, the Office Action takes the position that Hosea at paragraphs 0046 and 0047 discloses the third element of claim 1. Applicants respectfully note in response, however, that what Hosea at paragraphs 0046 and 0047 in fact discloses is:

To personalize a requested Web page, the Web page personalization component 124 analyzes the respective user profile and HTML file profile to determine the most effective organization for the content of the requested Web page for display to that particular user. The proxy server 114 preferably accesses the profiled version of the HTML file from the HTML file profile database 127. In accordance with the inventive system, the content of the Web page may be reorganized in several ways to produce a modified, personalized Web page. Certain content components, if deemed to be of low interest to the user, may be eliminated from the Web page display altogether. Generally, it is preferred to preserve access to all of the content of the original Web page. A link to "Other" content or

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a link to the original Web page may be provided and a message that the Web page has been personalized may be included in the modified HTML file to ensure that the user is able to access all of the content, if desired. Other content components may be rearranged to position content for which the user has a higher affinity so that it is more easily viewed, for example, by moving it to the top of a list, moving it "above the fold," or setting it apart so that it has more white space around it. Additional content may also be inserted if desired. For example, certain advertisements or links to articles may be included or excluded. Other advertisements or links to articles may be moved to better target the user's preferences. Content may also be modified so that the font or color or other graphics properties are changed.

The Web page personalization component 124 uses the classification of each content component from the profile to analyze its relevance to the requesting user. Content components may be matched to user profiles in any number of ways, for example, by using a certain threshold for the content affinity rating for a user to trigger content components corresponding to that content category. The proxy server 114 provides a modified Web page for display by creating a modified HTML file, with the included content components marked up with HTML code to specify the desired Web page display format.

That is, Hosea at paragraphs 0046 and 0047 discloses a web page personalization component that analyzes a user profile and an HTML file profile to determine the most effective organization for the content of the web page requested by a particular user. In addition, Hosea at paragraphs 0046 and 0047 discloses that the web page personalization component uses the classification of each content component from the user profile to analyze its relevance to the requesting user. Hosea's web page personalization component is not filtering the structured document in dependence upon the user classifications and the classification identifiers to create a session document. Readers

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will recall from the first element of claim 1 in the present application that a 'structured document having structured elements classified with classification identifiers' is included in a 'presentation document.' Hosea, however, never even once mentions a 'presentation document,' 'presentation document including a presentation grammar,' or 'presentation document including a presentation grammar and structured document having structural elements classified with classification identifiers.' Hosea at paragraphs 0046 and 0047, therefore, cannot disclose 'filtering the structured document in dependence upon the user classifications and the classification identifiers to create a session document' as claimed in the present application. Moreover, Hosea at paragraphs 0046 and 0047 has nothing whatsoever to do with creating a session document from a presentation document as claimed in the present application because Hosea at paragraphs 0046 and 0047 never once mentions a 'session document.' Because the combination of Hosea and Ladd does not disclose each and every element and limitation of Applicants' claims, combination of Hosea and Ladd does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Ladd Does Not Teach Or Suggest Identifying A Presentation
Document For A Presentation. The Presentation Document Including
A Presentation Grammar And A Structured Document Having Structural
Elements Classified With Classification Identifiers

The first element of claim 1 claims "identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers...." As mentioned above, the Office Action at page 3 admits that Hosea does not disclose identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application. By combining Ladd with Hosea, the Office Action does not cure the failure to disclose the first element of claim 1. Regarding the first element of claim 1, the Office Action at pages 3 and 4 states that Ladd at column 15, lines 60-64, column 16, lines 11-14, column

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13, line 66, through column 14, line 9, column 14, lines 10-42, and column 10, lines 12-20, discloses:

However, Hosea et al fails to disclose that the presentation document includes presentation grammar. On the other hand, Ladd et al discloses the use of voice grammar on a markup language document by using a voice browser. Ladd et al discloses the markup language contains text, navigational controls, and input controls for voice applications. (Column 15, lines 60-64) In addition, the markup language can include elements that place markers in the text to control interactive voice services. (Column 16, lines 11-14). With the use of the voice browser application, it fetches the markup language document for user interaction. (Column 13, lines 66 – Column 14, line 9). The voice browser collects user input and determines the grammar for user's speech recognition. It determines if a pre-determined grammar exists for the input and markup language. Once the grammar been found, it's sent to the VRU server recognize the user input by comparing the grammar to the user input. (Column 14, lines 10-42; FIG 5). In addition, Ladd et al discloses the use of a detection unit that compares audio inputs to the grammar stored in database. The detector monitors the inputs for key phrases or word, which is then sent to VRU for responses to the said key phrase. (Column 10, lines 12-20).

That is, the Office Action takes the position that Ladd at column 15, lines 60-64, column 16, lines 11-14, column 13, line 66, through column 14, line 9, column 14, lines 10-42, and column 10, lines 12-20, discloses the first element of claim 1. Applicants respectfully note in response, however, that what Ladd at column 15, lines 60-64, in fact discloses is:

The following text describes an exemplary markup language processed by the voice browser of the communication node 212. The markup language

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preferably includes text, recorded sound samples, navigational controls, and input controls for voice applications as further described below.

That is, Ladd at column 15, lines 60-64, discloses a description of an exemplary markup language processed by the voice browser. Ladd's description of an exemplary markup language processed by the voice browser is not identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application. As mentioned above, a presentation document is a document composed of a presentation grammar and a structured document. A presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. Ladd's description of an exemplary markup language processed by the voice browser, therefore, has nothing whatsoever to do with a presentation document and a presentation grammar as claimed in the present application. In fact, Ladd at column 15, lines 60-64, never even mentions 'presentation,' 'presentation document,' 'presentation grammar,' 'presentation document including a presentation grammar and a structured document,' or 'identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers.' Moreover, Ladd at column 15, lines 60-64, has nothing whatsoever to do with creating a session document from a presentation document as claimed in the present application because Ladd at column 15, lines 60-64, never once mentions a 'session document.' Because the combination of Hosea and Ladd does not disclose each and every element and limitation of Applicants' claims, combination of Hosea and Ladd does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Ladd at column 16, lines 11-14, Applicants respectfully note that what Ladd at column 16, lines 11-14, in fact discloses is:

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The markup language can include elements that describe the structure of a document or page, provide pronunciation of words and phrases, and place markers in the text to control interactive voice services.

That is, Ladd at column 16, lines 11-14, discloses a markup language that can include elements to describe the structure of a document, provide pronunciation of words and phrases, and place markers in the text to control interactive voice services. Ladd's markup language, however, is not identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application. As mentioned above, a presentation document is a document composed of a presentation grammar and a structured document. A presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. Ladd's markup language, therefore, has nothing whatsoever to do with a presentation document and a presentation grammar as claimed in the present application. In fact, Ladd at column 16, lines 11-14, never even mentions 'presentation,' 'presentation document,' 'presentation grammar,' 'presentation document including a presentation grammar and a structured document,' or 'identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers.' Moreover, Ladd at column 16, lines 11-14, has nothing whatsoever to do with creating a session document from a presentation document as claimed in the present application because Ladd at column 16, lines 11-14, never once mentions a 'session document.' Because the combination of Hosea and Ladd does not disclose each and every element and limitation of Applicants' claims, combination of Hosea and Ladd does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

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Turning now to Ladd at column 13, line 66, through column 14, line 9, Applicants respectfully note that what Ladd at column 13, line 66, through column 14, line 9, in fact discloses is:

FIGS. 5a-5c illustrate a flow diagram of a software routine executed by the voice browser 250. The software routine allows interactive voice applications. At block 400, the voice browser 250 determines an initial address (i.e., a URL) and a step element or name. The voice browser then fetches the contents (i.e., a markup or language document) of the current address from the information sources (i.e., content providers and markup language servers) at block 402. After the voice browser fetches the address, the voice browser processes the contents and builds a local step table (i.e., a tree structure) at block 404.

That is, Ladd at column 13, line 66, through column 14, line 9, discloses a software routine executed by a voice browser. Ladd's software routine executed by a voice browser is not identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application. As mentioned above, a presentation document is a document composed of a presentation grammar and a structured document. A presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. Ladd's software routine executed by a voice browser, therefore, has nothing whatsoever to do with a presentation document and a presentation grammar as claimed in the present application. In fact, Ladd at column 13, line 66, through column 14, line 9, never even mentions 'presentation,' 'presentation document,' 'presentation grammar,' 'presentation document including a presentation grammar and a structured document,' or 'identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers.' Moreover, Ladd at

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column 13, line 66, through column 14, line 9, has nothing whatsoever to do with creating a session document from a presentation document as claimed in the present application because Ladd at column 13, line 66, through column 14, line 9, never once mentions a 'session document.' Because the combination of Hosea and Ladd does not disclose each and every element and limitation of Applicants' claims, combination of Hosea and Ladd does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Ladd at column 14, lines 10-42, Applicants respectfully note that what Ladd at column 14, lines 10-42, in fact discloses is:

At block 406, a prompt can be played to the user via the TTS unit of the system 200 for the current element. The voice browser then waits for an input from the user (i.e., speech or DTMF tones). At block 408, the voice browser can collect input from the user for the current step element. FIG. 5c shows an exemplary flow diagram of a routine that is executed by the voice browser to determine the grammar for speech recognition.

At block 502, the voice browser determines whether a pre-determined grammar exists for the user input and the markup language. For example, the voice browser determines whether the grammar for the user input is found in a predetermined or pre-existing grammar stored in a database or contained in the markup language. If the grammar is found, the voice browser sends the grammar to the VRU server at block 504. At block 506, the VRU server compares the user input to the grammar to recognize the user input. After the VRU server recognizes the user input, the process proceeds to block 410 (see FIG. 5a) as described below.

If a pre-existing grammar is not found at block 502, the voice browser dynamically generates the grammar for the user input. At block 508, the voice browser looks up the pronunciations for the user in a dictionary at

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block 508. The dictionary can be stored in a database of the system or stored on an external database (i.e., the voice browser can fetch a dictionary from the processor or from the internet).

At block 510, the voice browser generates the grammar for the user inputs based upon the pronunciations from the dictionary and phonetic rules. A software routine available from Nuance Communication, Model No. RecServer, can be used to generate the grammar. At block 512, the grammar is sent to the VRU server. The voice browser then attempts to match the grammar to the user input at block 506.

That is, Ladd at column 14, lines 10-42, discloses a software routine executed by a voice browser. Ladd's software routine executed by a voice browser is not identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application. As mentioned above, a presentation document is a document composed of a presentation grammar and a structured document. A presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. Ladd's software routine executed by a voice browser, therefore, has nothing whatsoever to do with a presentation document and a presentation grammar as claimed in the present application. In fact, Ladd at column 14, lines 10-42, never even mentions 'presentation,' 'presentation document,' 'presentation grammar,' 'presentation document including a presentation grammar and a structured document,' or 'identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers.' Moreover, Ladd at column 14, lines 10-42, has nothing whatsoever to do with creating a session document from a presentation document as claimed in the present application because Ladd at column 14, lines 10-42, never once mentions a 'session document.' Because the combination of Hosea and Ladd does not

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disclose each and every element and limitation of Applicants' claims, combination of Hosea and Ladd does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Ladd at column 10, lines 12-20, Applicants respectfully note that what Ladd at column 10, lines 12-20, in fact discloses is:

The detection unit 260 records the audio inputs from the user and compares the audio inputs to the vocabulary or grammar stored in the database server unit 244. The detector unit continuously monitors the user's audio inputs for a key phrase or word after the user is connected to the node 212. When the key phrase or word is detected by the detection unit 260, the VRU client 232 plays a pre-recorded message to the user. The VRU client 232 then responds to the audio inputs provided by the user.

That is, Ladd at column 10, lines 12-20, discloses a detection unit that records the audio inputs from the user and compares the audio inputs to the vocabulary or grammar stored in the database server. Ladd's a detection unit is not identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application. As mentioned above, a presentation document is a document composed of a presentation grammar and a structured document. A presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. Ladd's detection unit, therefore, has nothing whatsoever to do with a presentation document and a presentation grammar as claimed in the present application. In fact, Ladd at column 10, lines 12-20, never even mentions 'presentation,' 'presentation document,' 'presentation grammar,' 'presentation document including a presentation grammar and a structured document,' or 'identifying a presentation document for a presentation, the presentation

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document including a presentation grammar and a structured document having structural elements classified with classification identifiers.' Moreover, Ladd at column 10, lines 12-20, has nothing whatsoever to do with creating a session document from a presentation document as claimed in the present application because Ladd at column 10, lines 12-20, never once mentions a 'session document.' Because the combination of Hosea and Ladd does not disclose each and every element and limitation of Applicants' claims, combination of Hosea and Ladd does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

No Suggestion Or Motivation To
Combine Hosea And Ladd

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Hosea and Ladd. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The suggestion or motivation to combine Hosea and Ladd must come from the teaching of either Hosea or Ladd themselves, and the Examiner must explicitly point to the teaching within Hosea or Ladd suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action makes no mention whatsoever of any place in any of the references that suggests or that provides any motivation for the proposed combination of Hosea and Ladd. Instead, the Office Action at page 4 merely asserts that the combination of Hosea and Ladd would be obvious to one of ordinary skill in the art. Such a bare assertion

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incorporates "hindsight" from the present application that is impermissible under *In re Surko*. Because the Office Action does not establish a prima facie case for obviousness, the rejections should be withdrawn, and the claims should be allowed.

In addition, Hosea or Ladd in fact do not suggest the combination. Creating a session document from a presentation document as claimed in the present application includes, among other things, 'identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers as claimed in the present application.' Hosea directed toward a system for web page personalization having nothing whatsoever to do with a presentation document and a presentation grammar as claimed in the present application. Ladd's description of a voice browser for interactive services does not suggest any combination with a system for web page personalization as disclosed in Hosea. Neither Hosea or Ladd, therefore, suggest or motivate the proposed combination. Because the Office Action does not establish a prima facie case for obviousness, the rejections should be withdrawn, and the claims should be allowed.

Conclusion For Claim Rejections

Under 35 U.S.C. § 103 Over

Hosea In View Of Ladd

Claims 1-2, 4-5, 10-11, 13-14, 19-20, and 22-23 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Hosea in view of Ladd. For the reason discussed above, the proposed combination of Hosea and Ladd does not establish a prima facie case of obviousness for independent claim 1 in the present application. Independent claim 1, therefore, is allowable. Independent claims 10 and 19 claim system and computer program product aspects, respectively, of the method claimed in independent claim 1. Independent claims 10 and 19 are allowable because independent claim 1 is allowable. The rejections of independent claims 1, 10, and 19, therefore, should be withdrawn, and claims 1, 10, and 19 should be allowed.

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Claims 2, 4, and 5 depend from independent claim 1. Claims 11, 13, and 14 depend from independent claim 10. Claims 20, 22, and 23 depend from independent claim 19. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Hosea and Ladd does not disclose or suggest each and every element of the independent claims, so also the combination of Hosea and Ladd cannot possibly disclose or suggest each and every element of any dependent claim. The rejections of claims 2, 4, 5, 11, 13, 14, 20, 22, and 23, therefore, should be withdrawn, and these claims also should be allowed.

In addition to the elements and limitations of the independent claims, the dependent claims 2, 4, 5, 11, 13, 14, 20, 22, and 23, also include such elements and limitations as 'inserting in a list a location for the presentation document,' 'inserting in a list a user identification identifying a user in a presentation participant list,' and 'extracting, from the structured document, structural elements having classification identifiers corresponding to the user classifications, and writing the extracted structural elements into a session structured document in the session document.' The proposed combination of Hosea and Ladd not only does not disclose the elements of the independent claims, but Hosea and Load do not disclose these additional elements. The rejections of claims 2, 4, 5, 11, 13, 14, 20, 22, and 23, therefore, should be withdrawn, and these claims also should be allowed.

**CLAIM REJECTIONS – 35 U.S.C. § 103 OVER HOSEA
IN VIEW OF LADD FURTHER IN VIEW OF CARTER**

Claims 3, 12, and 21 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Hosea, *et al.* (U.S. Pub. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336) further in view of Carter (U.S. Patent No. 5,787,175. To establish a prima facie case of obviousness, the proposed combination of Hosea, Ladd, and Carter must teach or suggest all of the claim limitations of dependent claims 3, 12, and 21. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action does

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not teach or suggest all of the claim limitations of claims 3, 12, and 21 because the rejection of claims 3, 12, and 21 relies on the previous 35 U.S.C. § 103 rejection. The previous 35 U.S.C. § 103 rejection argues that the proposed combination of Hosea and Ladd discloses each and every element and limitation of independent claims 1, 10, and 19. As Applicants have demonstrated above, the proposed combination of Hosea and Ladd does not disclose each and every element of independent claims 1, 10, and 19. Dependent claims 3, 12, and 21 depend from independent claims 1, 10, and 19 respectively and include all of the limitations of the claims from which they depend. Because the proposed combination of Hosea, Ladd, and Carter relies on the argument that the combination of Hosea and Ladd teaches each and every element claims 1, 10, and 19, and because the combination of Hosea and Ladd in fact does not teach or suggest each and every element of claim 1, 10, and 19, the proposed combination of Hosea, Ladd, and Carter cannot teach or suggest all the claim limitations of claims 3, 12, and 21. The proposed combination of Hosea, Ladd, and Carter therefore cannot establish a *prima facie* case of obviousness, and the rejections should be withdrawn.

In addition to the elements and limitations of the independent claims, the dependent claims 3, 12, and 21, also include such limitations as 'inserting in a list a user identification identifying a user in a presentation participant list.' The proposed combination of Hosea, Ladd, and Carter not only does not disclose the elements of the independent claims, but Hosea, Ladd, and Carter do not disclose these additional elements. The rejections of claims 3, 12, and 21, therefore, should be withdrawn, and these claims also should be allowed.

**CLAIM REJECTIONS – 35 U.S.C. § 103 OVER HOSEA
IN VIEW OF LADD FURTHER IN VIEW OF FELCIANO**

Claims 6, 15, and 24 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Hosea, *et al.* (U.S. Pub. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336) further in view of Felciano, *et al.* (U.S. Patent No. 6,052,730). To establish a *prima facie* case of obviousness, the proposed combination of Hosea, Ladd,

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and Felciano must teach or suggest all of the claim limitations of dependent claims 6, 15, and 24. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action does not teach or suggest all of the claim limitations of claims 6, 15, and 24 because the rejection of claims 6, 15, and 24 relies on the previous 35 U.S.C. § 103 rejection. The previous 35 U.S.C. § 103 rejection argues that the proposed combination of Hosea and Ladd discloses each and every element and limitation of independent claims 1, 10, and 19. Applicants have demonstrated above that the proposed combination of Hosea and Ladd does not disclose each and every element of independent claims 1, 10, and 19. Dependent claims 6, 15, and 24 depend from independent claims 1, 10, and 19 respectively and include all of the limitations of the claims from which they depend. Because the proposed combination of Hosea, Ladd, and Felciano relies on the argument that the combination of Hosea and Ladd teaches each and every element claims 1, 10, and 19, and because the combination of Hosea and Ladd in fact does not teach or suggest each and every element of claim 1, 10, and 19, the proposed combination of Hosea, Ladd, and Felciano cannot teach or suggest all the claim limitations of claims 6, 15, and 24. The proposed combination of Hosea, Ladd, and Felciano therefore cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

In addition to the elements and limitations of the independent claims, the dependent claims 6, 15, and 24, also include such limitations as 'storing the location of the session document in a session document list.' The proposed combination of Hosea, Ladd, and Felciano not only does not disclose the elements of the independent claims, but Hosea, Ladd, and Felciano do not disclose these additional elements. The rejections of claims 6, 15, and 24, therefore, should be withdrawn, and these claims also should be allowed.

**CLAIM REJECTIONS – 35 U.S.C. § 103 OVER HOSEA
IN VIEW OF LADD FURTHER IN VIEW OF HUANG**

Claims 7-9, 16-18, and 25-27 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Hosea, *et al.* (U.S. Pub. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336) further in view of Huang, *et al.* (U.S. Pub. 2001/0032218).

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To establish a prima facie case of obviousness, the proposed combination of Hosea, Ladd, and Huang must teach or suggest all of the claim limitations of dependent claims 7-9, 16-18, and 25-27. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action does not teach or suggest all of the claim limitations of claims 7-9, 16-18, and 25-27 because the rejection of claims 7-9, 16-18, and 25-27 relies on the previous 35 U.S.C. § 103 rejection. The previous 35 U.S.C. § 103 rejection argues that the proposed combination of Hosea and Ladd discloses each and every element and limitation of independent claims 1, 10, and 19. Applicants have demonstrated above that the proposed combination of Hosea and Ladd does not disclose each and every element of independent claims 1, 10, and 19. Dependent claims 7-9, 16-18, and 25-27 depend from independent claims 1, 10, and 19 respectively and include all of the limitations of the claims from which they depend. Because the proposed combination of Hosea, Ladd, and Huang relies on the argument that the combination of Hosea and Ladd teaches each and every element claims 1, 10, and 19, and because the combination of Hosea and Ladd in fact does not teach or suggest each and every element of claim 1, 10, and 19, the proposed combination of Hosea, Ladd, and Huang cannot teach or suggest all the claim limitations of claims 7-9, 16-18, and 25-27. The proposed combination of Hosea, Ladd, and Huang therefore cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

In addition to the elements and limitations of the independent claims, the dependent claims 7-9, 16-18, and 25-27, include such elements and limitations, among others, as 'creating a presentation document' and 'creating a presentation grammar.' The proposed combination of Hosea, Ladd, and Huang not only does not disclose the elements of the independent claims, but Hosea, Ladd, and Huang do not disclose these additional elements. The rejections of claims 7-9, 16-18, and 25-27, therefore, should be withdrawn, and these claims also should be allowed.

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CONCLUSION

Claims 1-2, 4-5, 10-11, 13-14, 19-20, and 22-23 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Hosea, *et al.* (U.S. Pub. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336). For the reasons discussed above, the proposed combination of Hosea and Ladd does not establish a prima facie case for obviousness. Claims 1-2, 4-5, 10-11, 13-14, 19-20, and 22-23, therefore, are patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-2, 4-5, 10-11, 13-14, 19-20, and 22-23.

Claims 3, 12, and 21 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Hosea, *et al.* (U.S. Pub. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336) further in view of Carter (U.S. Patent No. 5,787,175). For the reasons discussed above, the proposed combination of Hosea, Ladd, and Carter does not establish a prima facie case for obviousness. Claims 3, 12, and 21, therefore, are patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 3, 12, and 21.

Claims 6, 15, and 24 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Hosea, *et al.* (U.S. Pub. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336) further in view of Felciano, *et al.* (U.S. Patent No. 6,052,730). For the reasons discussed above, the proposed combination of Hosea, Ladd, and Felciano does not establish a prima facie case for obviousness. Claims 6, 15, and 24, therefore, are patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 6, 15, and 24.

Claims 7-9, 16-18, and 25-27 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Hosea, *et al.* (U.S. Pub. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336) further in view of Huang, *et al.* (U.S. Pub. 2001/0032218). For the reasons discussed above, the proposed combination of Hosea, Ladd, and Huang does not establish a prima facie case for obviousness. Claims 7-9, 16-18, and 25-27 are

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therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 7-9, 16-18, and 25-27.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: April 6, 2006

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